

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1, 2, 4-13, and 16-25 are pending in the present application. Claims 3, 14, and 15 have been canceled without prejudice or disclaimer. Claim 21 has been amended by the present amendment to correct an obvious typographical error (“signall” changed to--signal--).

The outstanding Action presents an objection to Claim 5 under 37 CFR § 1.75(c), a rejection of Claims 1, 2, 4-8, and 15 under the second paragraph of 35 U.S.C. §112, a rejection of Claims 1, 2, 7-10, 16-19, and 21-25 under 35 U.S.C. §103(a) as unpatentable over Gilbert (U.S. Patent No. 6,204,719) in view of Takai et al. (U.S. Patent No. 6,163,190, Takai), and a rejection of Claims 4-6, 11-15, and 20 under 35 U.S.C. §103(a) as unpatentable over Gilbert in view of Kraz (U.S. Patent No. 6,563,319).

The objection to Claim 5 under 37 CFR § 1.75(c) is clearly based upon the failure to appreciate that parent Claim 1, from which Claim 5 depends, is generic and reads on both FIGS. 4 and 13, not just on FIG. 13. There is nothing objectionable in Claim 5 depending from Claim 1 that reads on both FIGS. 4 and 13. Accordingly withdrawal of this objection is respectfully submitted to be in order.

Turning to the stated rejection of Claims 1, 2, 4-8 and 15 under the second paragraph of 35 U.S.C. §112, it is first noted that the cancellation of Claim 15 renders its rejection on this ground as being moot.

The rejection of Claim 1 under the second paragraph of 35 U.S.C. §112 is respectfully traversed because it is clearly based upon an improper interpretation of the Claim 1 recited “control circuit” as only being the “differential amplifier” 116 of FIG. 4. This interpretation is improper because the claim requires the output stage to be part of the control circuit.

Transistors 122 and 123 of FIG. 4 are not part of “differential amplifier” 116. Also, the claim language requiring the output stage to be “connected” to the “control input” cannot be said to require a “direct” connection as improperly suggested by this rejection. Thus, it is believed that the rejection of Claim 1 under the second paragraph of 35 U.S.C. §112 is clearly improper and should be withdrawn.

The claim language “common gate” of Claims 1, 9, 16, and 21 is further mistakenly suggested to be unclear. However, Claims 9 and 16 were not listed in the statement of this rejection and cannot be inferentially included. In addition, the assertion that the true artisan would not understand the term “common gate” of Claims 1, 9, 16, and 21 has been improperly made by considering this claim language in a vacuum and not in the context of the disclosure. In this last regard, the guidelines of the MPEP, and the case law cited therein, establish that claim language must always be interpreted in light of the support for this language that appears in the specification. See MPEP §2173.02:

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

The present specification discloses (at page 11, line 22 – page 12, line 5, for example) the output stage elements and the meaning of the language “common gate” in terms of describing the gates of transistors 122 and 123 that receive the control signal are directly interconnected (as further shown FIGS. 4, 13, 16, 18, and 19).

With regard to Claim 7, the drawing that this claim reads on is clearly at least Fig. 13. It appears that this indefinite rejection applied to Claim 7 is also without merit as the

dependency of Claim 7 on Claim 6 has been ignored. Claim 6 requires the control input to include “a connection node directly connecting between an output terminal of the first voltage/current conversion circuit and an output terminal of the second voltage/current conversion circuit, and a capacitor connected between the connection node and a ground. Thus the currents are clearly disclosed.

With respect to the rejection of Claims 1, 2, 7-10, 16-19, and 21-25 under 35 U.S.C. § 103(a) as being unpatentable over Gilbert in view of Takai is also respectfully traversed.

In this regard, the rejection is clearly improper because the required showing of reasonable motivation to include the wave forming circuit 20 of Takai as a modification to Gilbert is lacking. In this regard, simply because the wave forming circuit 20 was “known,” this alone does not make it obvious to use it as an output stage to replace or augment the Gilbert RMS-to-DC converter output buffer amp 18. The triangular wave provided by the wave form circuit 20 of Takai is completely unrelated to the current output of 16 of Gilbert or the buffered output from 18 of Gilbert.

As noted by the court in *In re Lee*, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1432-33 (Fed. Cir. 2002):

... the agency tribunal must present a full and reasoned explanation of its decision. The agency tribunal must set forth its findings and the grounds thereof, as supported by the agency record, and explain its application of the law to the found facts.

Further note *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) as follows:

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir.1998). Thus, every element of a claimed invention may often be found in the prior art. *See id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *See In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Clearly, more than establishing the mere existence of Takai is required to establish a logical basis why the artisan would have been led to believe there would have been some benefit from attempting to modify the completely unrelated current output of 16 of Gilbert or the buffered output from 18 of Gilbert to include a triangular wave as would appear from the wave form circuit 20 of Takai. Note *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985):

Presuming *arguendo* that the references show the elements or concepts urged by the examiner, the examiner has presented no line of reasoning, and we know of none, as to why the artisan viewing only the collected teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. In the instant application, the examiner has done little more than cite references to show that one or more elements, or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of elements. That is to say, appellant does not claim that he has invented one or more new elements, but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

Accordingly, withdrawal of this rejection is respectfully requested.

The stated rejection of Claims 4-6, 11-15, and 20 under 35 U.S.C. § 103(a) as unpatentable over Gilbert in view of Kraz is also traversed.

First, the cancellation of Claims 14 and 15 renders the rejection thereof over these references moot.

In addition, it is clear that Claims 4-6 depend from Claim 1 and Claim 20 depends on Claim 16. Neither Gilbert nor Kraz teach the “output stage” having “a common gate connected to the control input” of these parent claims. Similarly, Claims 11-15 depend from Claim 9. Once again, neither Gilbert nor Kraz teach the parent Claim 9 recited “common gate connected to receive the comparison output signal of the comparator.” As not all the

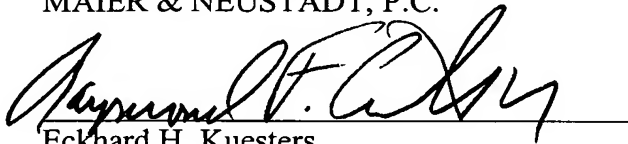
limitations of Claims 4-6, 11-13, and 20 are taught by the applied references, no *prima facie* case of obviousness can be said to be established. See MPEP § 2143.03.

Accordingly, the withdrawal of this rejection of Claims 4-6, 11-13, and 20 under 35 U.S.C. §103(a) is also respectfully submitted to be in order.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

A handwritten signature in black ink, appearing to read 'Eckhard H. Kuesters', is written over a horizontal line.

Eckhard H. Kuesters
Attorney of Record
Registration No. 28,870
Raymond F. Cardillo, Jr.
Registration No. 40,440

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

EHK:RFC:jmp